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10/077,041	02/15/2002	Max Stern	STN.0108	1910

7590

09/24/2003

Jeffrey C. Maynard  
325 CRESWELL ROAD  
SEVERNA PARK, MD 21146

EXAMINER

BROCKETTI, JULIE K

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/077,041

Applicant(s)

STERN, MAX

Examiner

Julie K Brockett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Objections***

The disclosure is objected to because of the following informalities:

Page 11 line 21, "ahs" should be "has".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All of the claims recites the word "such" as in "such game" or "such controller" etc. The Applicant is using the word "such" in trying to link the item the previously mentioned limitation in a claim. However, by using the word "such" it does not necessarily link the words to a previously mentioned limitation. For example, when using the phrase "such game controller". The phrase does not have to refer back to "a game controller" previously mentioned in the claim. It could refer to a game controller that is merely similar to the one previously mentioned. Therefore, Applicant is advised to change all of the words "such" to "said" to correct the problem.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 11-14, 16, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Travis et al., U.S. Patent No. 5,380,007. Travis et al. discloses a gaming device and method. The game is a slot machine and includes game initiating means to initiate a game on the machine (col. 2 lines 7-9). A display means is disposed to display the game being played on the machine. The display means is arranged to display a plurality of elements having indicia each associated with a symbol. The machine further includes buttons indicating grid reference on the display so that indicia positions may be selected by pressing the buttons (Fig. 4; col. 2 lines 3-5; col. 3 lines 41-50). The display is an electromechanical device (Fig. 1; col. 2 lines 32-34). The game has a game controller, which provides a first set of contest elements having a surface area with playing indicia on the surface area. The game controller elements are displayed to a player of the game. The player is then permitted to select a plurality of elements from the first set of elements for game play (col. 2 lines 3-5). A table of values is established for matching the

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selected contest elements based on the number of elements selected (col. 3 lines 51-54). The controller then provides a sufficient number of additional sets of contest elements. The additional number of sets is equal to the number of elements selected by the player for play of the game and each additional set is identical to the first set of elements. The controller then randomly selects one element from each of the additional sets of elements and compares the randomly selected elements to a user selected contest elements obtained. The controller then evaluates the number of matched contest elements selected by the player against the table of values (Fig. 3; col. 7 lines 23-41). The number of contest elements in the first set is at least ten and the player selects at least two elements from the first set of contest elements. The player selects no more than eight elements from the first set of contest elements. The playing indicia comprise representations of numerals 0, 1, 2, 3, 4, 5, 6, 7, 8, 9 (Fig. 1). The game controller is an electronic video game machine, i.e. a computer. Players may place a wager on each possible matching outcome. If the player has a winning combination of contest elements as determined by the table of values according to the player's wager, the player is paid an award. The game has an electronic system for playing a slot machine game and has a plurality of play options wherein a win or a loss is determined after each play of the game. The system includes a game enclosure, including a player interface means for a player to physically interact with the system. A bet value entry means is used for generating a bet value signal to the system representing an amount of a bet

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placed by a player (col. 4 lines 35-50). Player display means visually indicates to the player a set of elements having indicia thereon. Player selection means allows the player to select a plurality of elements from the set of elements (col. 4 lines 53-55). A game control means is responsive to the player selection means wherein control means randomly selects from the set of elements having indicia thereon equal to a number of elements (Fig. 1). A processor compares the indicia on the player selected elements to the indicia on the randomly selected elements and awards a prize to the player in the event that one or more of the user selected elements matches the randomly selected elements (Fig. 6). The processor means is electrically connected to the player display means, the player selection means, the bet value entry means and to the game control means (Fig. 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Travis et al., U.S. Patent No. 5,380,007. Travis et al. discloses all of the limitations mentioned above including that the game

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controller is an electronic video game machine, i.e. a computer. It would have been obvious at the time the invention was made that the game controller can be selected from the group consisting of electronic video game machines, mechanical game machines, computers, hand-held mechanical devices and hand-held video devices. All of these types of machines are well known in the art and are capable of implementing the game method described in Travis et al. It is up to the inventor's discretion which game machine to use. Players enjoy all types of gaming machines and by implanting the method of Travis et al. on various machines; more players would be interested in the game.

Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Travis et al., in view of Morro et al., U.S. Patent No. 5,947,820. Travis et al. lacks in disclosing a touch sensitive screen and a set of rotatable reels. Morro et al. discloses an electronic game in which the display means comprises a touch sensitive video screen and the player selects indicia by touching areas on the screen in which the indicia are displayed (See Morro et al. col. 3 lines 43-48). The display means further comprises a set of rotatable reels (See Morro et al. Fig. 2). It would have been obvious at the time the invention was made to use a touch screen display in the invention of Travis et al. Touch screens are well known in the art and allow the player to directly touch the item they wish to select. It simplifies the selection process for the player and they do not need to learn how various buttons operate. It would also have been obvious at the time the invention was made to use rotatable

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reels in the invention of Travis et al. Many games use rotatable reels to simulate the selection of a random number or symbol. Players have enjoyed games with rotatable reels throughout the years and it is obvious to implement this display method in Travis et al. in order to appeal to those players who enjoy rotatable reel games.

### ***Citation of Relevant Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Luciano, U.S. Patent No. 6,368,214 B1.

--Luciano discloses a method of playing keno. Players select certain indicia and then it is determined if the indicia selected by the player matches indicia that is randomly selected by the computer.

2. Byrne, U.S. Patent No. 6,336,862 B1.

--Byrne discloses a method for playing a gambling game in which players bet on whether or not they will match randomly selected numbers.

3. Dodge, U.S. Patent No. 6,270,407 B1.

--Dodge discloses a partition keno game in which players select between two and ten numbered spots, which are compared to twenty numbers drawn from a keno pool.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone

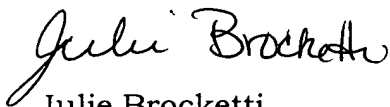


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number is 703-308-7306. The examiner can normally be reached on M-Th  
7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the  
examiner's supervisor, Teresa Walberg SPE can be reached on 703-308-1327.  
The fax phone numbers for the organization where this application or  
proceeding is assigned are 703-872-9302 for regular communications and 703-  
872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this  
application or proceeding should be directed to the customer service office  
whose telephone number is 703-306-5648.



Julie Brockett  
Examiner

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September 17, 2003